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*Admitted only in Maryland
*Admitted only in Virginia
*Practice limited to
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November 12, 2004

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Mail Stop: Amendment

Re: U.S. Utility Patent Application
Appl. No. 09/732,914; Filed: December 11, 2000
For: **Use of Multiple Recombination Sites with Unique Specificity in
Recombinational Cloning**
Inventors: CHEO *et al.*
Our Ref: 0942.5010002/RWE/BJD/JKM

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Tenth Supplemental Information Disclosure Statement;
2. List of cited references on Form PTO-1449 (6 sheets);
3. Copies of references **AO9-AP9, AL10-AO10 and AS117-AS122** listed on Form PTO-1449 (22 documents);
4. Eleventh Supplemental Information Disclosure Statement;
5. List of cited references on Form PTO-1449 (14 sheets);
6. Copies of references **AR200-AR213** listed on Form PTO-1449 (40 documents); and
7. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
November 12, 2004
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

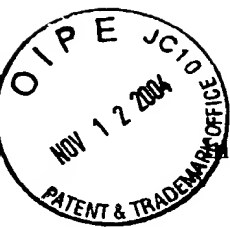
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "For: [unclear]", written over the printed name of the attorney.

Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

BJD/JKM:bac
Enclosures

333128_1.DOC



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re application of:

Cheo *et al.*

Appl. No.: 09/732,914

Filed: December 11, 2000

For: **Use of Multiple Recombination
Sites with Unique Specificity in
Recombinational Cloning**

Confirmation No.: 2341

Art Unit: 1636

Examiner: Ketter, J.S.

Atty. Docket: 0942.5010002/RWE/BJD/JKM

Tenth Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

The numbering on this Tenth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Ninth Supplemental Information Disclosure Statement filed April 21, 2004, in connection with the above-captioned application.

Copies of documents **AC7-AK7**, **AA8-AK8** and **AA9-AE9** are not provided in accordance with the Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, effective October 21, 2004, which states "section 1.98(a)(2)(i) is amended to eliminate the requirement in paragraph (a)(2)(i) for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application regardless of the filing date of the application." A copy of each other document is provided.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed

Cheo *et al.*
Appl. No. 09/732,914

publication dates on the attached Form PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Information Disclosure Statement is being filed before the mailing of a first Office Action after the filing of a Request for Continued Examination under 37 C.F.R. § 1.114. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed Form PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

Date: Nov. 12, 2004
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330913_1.DOC

FORM PTO-1449

TENTH SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENTATTY. DOCKET NO.
0942.5010002/RWE/BJD/JKMAPPLICATION NO.
09/732,914APPLICANT(S)
Cheo *et al.*FILING DATE
December 11, 2000ART UNIT
1636

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC7	2002/0007051	01/17/2002	Cheo <i>et al.</i>			12/11/2000
	AD7	2002/0068290	06/06/2002	Yarovinsky			05/31/2001
	AE7	2002/0094574	07/18/2002	Hartley <i>et al.</i>			05/16/2001
	AF7	2002/0172997	11/21/2002	Hartley <i>et al.</i>			07/19/2001
	AG7	2002/0192819	12/19/2002	Hartley <i>et al.</i>			07/19/2001
	AH7	2003/0027289	02/06/2003	Farmer			04/05/2002
	AI7	2003/0054555	03/20/2003	Farmer <i>et al.</i>			09/17/2002
	AJ7	2003/0054552	03/20/2003	Hartley <i>et al.</i>			01/30/2002
	AK7	2003/0059900	03/27/2003	Farmer			01/17/2002

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO9	WO 01/31039	05/03/2001	WIPO			Yes No
	AP9	WO 02/00875	01/03/2002	WIPO			Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR		
	AS	117	Ball, C.A. and Johnson, R.C., "Efficient Excision of Phage λ from the <i>Escherichia coli</i> Chromosome Requires the Fis Protein," <i>J. Bacteriol.</i> 173: 4027-4031, American Society for Microbiology (July 1991)
	AT	117	Bruckner, R.C. and Cox, M.M., "The Histone-like H Protein of <i>Escherichia coli</i> is ribosomal protein S3," <i>Nucl. Acids Res.</i> 17:3145-3161, Oxford University Press (1989)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

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U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA8	2003/0064515	04/03/2003	Hartley <i>et al.</i>			01/30/2002
	AB8	2003/0068799	04/10/2003	Hartley <i>et al.</i>			06/06/2002
	AC8	2003/0077804	04/24/2003	Byrd <i>et al.</i>			04/19/2002
	AD8	2003/0124555	07/03/2003	Brasch <i>et al.</i>			05/21/2002
	AE8	2003/0153055	08/14/2003	Miles <i>et al.</i>			02/20/2003
	AF8	2003/0157716	08/21/2003	Hartley <i>et al.</i>			11/02/2001
	AG8	2003/0157662	08/21/2003	Gerard <i>et al.</i>			11/13/2002
	AH8	2003/0175970	09/18/2003	Hartley <i>et al.</i>			11/21/2002
	AI8	2003/0176644	09/18/2003	Byrd <i>et al.</i>			02/07/2002
	AJ8	2003/0186233	10/02/2003	Chesnut <i>et al.</i>			12/07/2001
	AK8	2003/0220249	11/27/2003	Hackett <i>et al.</i>			02/07/2003

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL10	WO 02/08391	01/31/2002	WIPO			Yes No
	AM10	WO 02/16594	02/28/2002	WIPO			Yes No
	AN10	WO 02/61034	08/08/2002	WIPO			Yes No
	AO10	WO 03/25161	03/27/2003	WIPO			Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>118</u>	Hartley, J.L., <i>et al.</i> , "DNA Cloning Using In Vitro Site-Specific Recombination," <i>Genome Res.</i> 10:1788-1795, Cold Spring Harbor Laboratory Press (November 2000)
AS	<u>118</u>	Heyman, J.A., <i>et al.</i> , "Genome-Scale Cloning and Expression of Individual Open Reading Frames Using Topoisomerase I-Mediated Ligation," <i>Genome Res.</i> 9:383-392, Cold Spring Harbor Laboratory Press (April 1999)
AT	<u>118</u>	Lenski, R.E., <i>et al.</i> , "Genetic Analysis of a Plasmid-Encoded, Host Genotype-Specific Enhancement of Bacterial Fitness," <i>J. Bacteriol.</i> 176:3140-3147, American Society For Microbiology (1994)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449

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INFORMATION DISCLOSURE STATEMENTATTY. DOCKET NO.
0942.5010002/RWE/BJD/JKMAPPLICATION NO.
09/732,914APPLICANT(S)
Cheo *et al.*FILING DATE
December 11, 2000ART UNIT
1636

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA9	2004/0053412	03/18/2004	Hartley <i>et al.</i>			03/26/2003
	AB9	2004/0063207	04/01/2004	Hartley <i>et al.</i>			10/08/2003
	AC9	6,720,140	04/13/2004	Hartley <i>et al.</i>			02/04/2000
	AD9	2004/0171156	09/02/2004	Hartley <i>et al.</i>			04/02/2004
	AE9	2004/0171157	09/02/2004	Hartley <i>et al.</i>			04/08/2004
	AF						
	AG						
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	AI						
	AJ						
	AK						

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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>119</u>	Ohara, O. and Temple, G., "Directional cDNA library construction assisted by the <i>in vitro</i> recombination reaction," <i>Nucl. Acids Research</i> 29:e22(1-8), Oxford University Press (2001)
	AS	<u>119</u>	Russell, M., "A recombination-based cloning system that decreases time to protein analysis," <i>Am. Biotechnol. Lab.</i> 18:8,10, International Scientific Communications, Inc. (June 2000)
	AT	<u>119</u>	Sinclair, B., "Honing Your Cloning," <i>The Scientist</i> 14:29-32, The Scientist Inc. (August 21, 2000)

EXAMINER

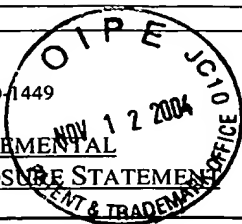
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 ATTY. DOCKET NO.
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 APPLICATION NO.
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 Cheo *et al.*

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FOREIGN PATENT DOCUMENTS

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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>120</u>	Invitrogen Online Catalog, "The Echo™ Cloning System: The Future of Cloning is Here," available at: http://web.archive.org/web/20010112191100/www.invitrogen.com/catalog_project/cat_echo.html (accessed July 7, 2004)
AS	<u>120</u>	Invitrogen Online Catalog, "The Echo™ Cloning System: The Future of Cloning is Here," available at: http://invitrogen.com/content.cfm?pageid=3371&cfd=16767784&cftoken=62396683 (accessed July 7, 2004)
AT	<u>120</u>	Office Action for U.S. Patent Application No. 09/907,719, mailed on July 13, 2004

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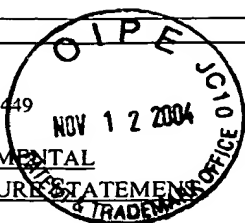
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TENTH SUPPLEMENTAL

INFORMATION DISCLOSURE STATEMENTS


 ATTY. DOCKET NO.
 0942.5010002/RWE/BJD/JKM

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U.S. PATENT DOCUMENTS

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	AA						
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FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>121</u>	Office Action for U.S. Patent Application No. 09/432,085, mailed on July 16, 2004
AS	<u>121</u>	Office Action for U.S. Patent Application No. 10/058,291, mailed on September 22, 2004
AT	<u>121</u>	Office Action for U.S. Patent Application No. 10/058,292, mailed on September 22, 2004

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-7449

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TENTH SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENTATTY. DOCKET No.
0942.5010002/RWE/BJD/JKMAPPLICATION No.
09/732,914APPLICANT(S)
Cheo *et al.*FILING DATE
December 11, 2000ART UNIT
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U.S. PATENT DOCUMENTS

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	AA						
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FOREIGN PATENT DOCUMENTS

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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

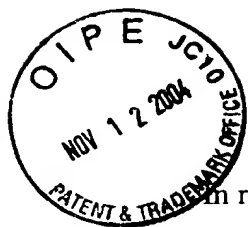
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>122</u>	Office Action for U.S. Patent Application No. 09/855,797, mailed on October 1, 2004
	AS	<u>122</u>	Office Action for U.S. Patent Application No. 09/695,065, mailed on October 27, 2004
	AT		

EXAMINER

DATE CONSIDERED

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Cheo *et al.*

Appl. No.: 09/732,914

Filed: December 11, 2000

For: **Use of Multiple Recombination
Sites with Unique Specificity in
Recombinational Cloning**

Confirmation No.: 2341

Art Unit: 1636

Examiner: Ketter, J.S.

Atty. Docket: 0942.5010002/RWE/BJD/JKM

Eleventh Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Copies of documents **AA20-AE20** are not provided in accordance with the Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, effective October 21, 2004, which states "section 1.98(a)(2)(i) is amended to eliminate the requirement in paragraph (a)(2)(i) for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application regardless of the filing date of the application." A copy of each other document is provided.

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Cheo *et al.*
Appl. No. 09/732,914

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It is respectfully requested that the Examiner initial and return a copy of the enclosed Form PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

Date: Nov. 12, 2004
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600
330917_1.DOC

FORM PTO-1449 NOV 12 2004

ELEVENTH SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENTATTY. DOCKET NO.
0942.5010002/RWE/BJD/JKMAPPLICATION NO.
09/732,914APPLICANT(S)
Cheo *et al.*FILING DATE
December 11, 2000ART UNIT
1636

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA20	4,808,537	02/28/1989	Stroman <i>et al.</i>			10/30/1984
	AB20	4,855,231	08/08/1989	Stroman <i>et al.</i>			09/25/1985
	AC20	4,959,217	09/25/1990	Sanders <i>et al.</i>			05/22/1986
	AD20	5,654,182	08/05/1997	Wahl <i>et al.</i>			06/07/1995
	AE20	2002/0106797	08/08/2002	Miles <i>et al.</i>			03/12/2001
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	AH						
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	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

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	AL						Yes No
	AM						Yes No
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	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

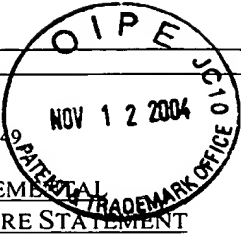
	AR	<u>200</u>	Agah, R., <i>et al.</i> , "Gene Recombination in Postmitotic Cells. Targeted Expression of Cre Recombinase Provokes Cardiac-restricted, Site-specific Rearrangement in Adult Ventricular Muscle In Vivo," <i>J. Clin. Invest.</i> 100:169-179, The American Society for Clinical Investigation, Inc. (July 1997)
	AS	<u>200</u>	Benoist, C. and Chambon, P., "In vivo sequence requirements of the SV40 early promoter region," <i>Nature</i> 290:304-310, Macmillan Journals, Ltd. (1981)
	AT	<u>200</u>	Botstein, D., <i>et al.</i> , "Making Mutations <u>In Vitro</u> and Putting Them Back Into Yeast," in <i>From Gene to Protein: Translation into Biotechnology</i> , Ahmad, F., <i>et al.</i> , eds., Academic Press, New York, NY, pp. 265-274 (1982)

EXAMINER

DATE CONSIDERED

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Page 2 of 14



FORM PTO-1449

**ELEVENTH SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT**

ATTY. DOCKET NO. 0942.5010002/RWE/BJD/JKM	APPLICATION NO. 09/732,914
APPLICANT(S) Cheo <i>et al.</i>	
FILING DATE December 11, 2000	ART UNIT 1636

U.S. PATENT DOCUMENTS							
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	AA						
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	AR	<u>201</u>	Broach, J.R., "The Yeast Plasmid 2 μ Circle," <i>Cell</i> 28:203-204, MIT (1982)
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ATTY. DOCKET NO.
0942.5010002/RWE/BJD/JKM

APPLICATION NO.
09/732,914

APPLICANT(S)
Cheo *et al.*

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	AR	<u>202</u>	Crellin, P.K. and Rood, J.I., "The Resolvase/Invertase Domain of the Site-Specific Recombinase TnpX Is Functional and Recognizes a Target Sequence That Resembles the Junction of the Circular Form of the <i>Clostridium perfringens</i> Transposon Tn4451," <i>J. Bacteriol.</i> 179:5148-5156, American Society for Microbiology (August 1997)
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	AR	<u>206</u>	Lyznik, L.A., <i>et al.</i> , "Activity of yeast FLP recombinase in maize and rice protoplasts," <i>Nucleic Acids Res.</i> 21:969-975, Oxford University Press (1993)
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	AR	<u>207</u>	McKnight, S.L., "Functional Relationships between Transcriptional Control Signals of the Thymidine Kinase Gene of Herpes Simplex Virus," <i>Cell</i> 31:355-365, MIT (1982)
	AS	<u>207</u>	Nunes-Duby, S.E., <i>et al.</i> , "λ Integrase cleaves DNA <i>in cis</i> ," <i>EMBO J.</i> 13:4421-4430, Oxford University Press (1994)
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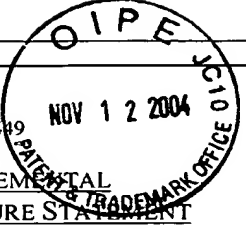
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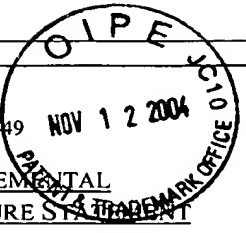
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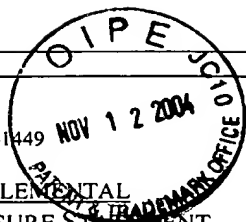
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